

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

IQE PLC,
Petitioner

v.

CORNELL RESEARCH FOUNDATION INC.,
Patent Owner

Case IPR2024-00609
U.S. Patent No. 7,250,360

**PETITIONER'S REPLY TO
PATENT OWNER'S PRELIMINARY RESPONSE**

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The Petition explained how an ongoing district court proceeding, which does not include Petitioner or Patent Owner as named parties, did not justify discretionary denial under *Fintiv*. Pet., 71-75. All of the arguments made still apply. However, since the Petition was filed, there have been two new developments. *First*, Qorvo—the named Defendant in the district court proceeding involving the '360 patent (“the *Akoustis-Qorvo* litigation”)—filed its own IPR Petition, in which it unambiguously made “a *Sotera*-type stipulation.” IPR2024-00758, Paper 1, 68-70. *Second*, Patent Owner (“PO”) filed its POPR in which it made multiple mischaracterizations relating to discretionary denial. These new developments weigh even more strongly against discretionary denial.

Petitioner accordingly requested authorization on June 24, 2024, to file a Reply to the POPR to address these new developments, which was granted on July 2, 2024. As authorized, Petitioner addresses these new developments below.

I. QORVO’S *SOTERA-TYPE* STIPULATION

Shortly after the instant Petition was filed, Qorvo filed its own IPR Petition along with a Motion for Joinder. IPR2024-00758, Papers 1, 3. In its Petition, Qorvo made “a *Sotera*-type stipulation.” IPR2024-00758, Paper 1, 68-70 (stipulating that “if the Board institutes this Petition, Petitioner will not pursue invalidity of the Challenged Claims in the *Akoustis-Qorvo* litigation on the grounds raised, or that reasonably could have been raised, in this IPR Petition”). As

indicated (at page 9) in Director Vidal’s June 21, 2022 Memorandum: Interim Procedure for Discretionary Denials, “the PTAB will not deny institution of an IPR ... under *Fintiv* ... where a petitioner stipulates not to pursue in a parallel district court proceeding the same grounds as in the petition or any grounds that could have reasonably been raised in the petition.” Thus, Qorvo’s *Sotera*-type stipulation in its Petition, which is sought to be joined with the instant Petition, should end the discretionary denial inquiry in favor of institution.

II. PATENT OWNER’S MISREPRESENTATIONS

Additionally, denial under *Fintiv* is not appropriate for at least the reasons set forth in the Petition, and because PO’s arguments to the contrary are based on critical misrepresentations and omissions.

Factor 2: While PO is correct that trial in the *Akoustis-Qorvo* litigation is tentatively set to begin before a final written decision would be expected in this proceeding, PO fails to mention that multiple pending issues in that case are likely to impact this trial date. *First*, on May 1, 2024 (six weeks before the POPR was filed), Akoustis filed a Motion for Leave to Add Patent Owner as a Co-Plaintiff to the *Akoustis-Qorvo* litigation. *Akoustis Technologies, Inc. et al. v. Qorvo, Inc.*, Case No. 2:23-cv-00180 (E.D. Tex.), Dkt. 84. Akoustis’ motion came *10 months after* Qorvo first raised the issue of joining PO as a party to that case. *Id.*, Dkt. 99. Despite Akoustis’ delay, Qorvo was willing to consent to the joinder of PO so long

as the case schedule was modified to allow for necessary discovery relating to the joinder. *Id.* Akoustis did not agree, and the motion is now awaiting a decision.

Second, Qorvo filed a Motion to Dismiss the *Akoustis-Qorvo* litigation on June 30, 2023. That motion is pending. Should that motion be granted, the *Akoustis-Qorvo* litigation would either end, or be effectively stayed for an indeterminate length.

These pending motions (both omitted from the POPR) raise real questions as to the reliability of the currently-scheduled trial date in the *Akoustis-Qorvo* litigation.

Factor 3: PO's allegations relating to the level of investment in the *Akoustis-Qorvo* litigation should be given little weight, as they are premised on the narrative that the parties to the instant proceeding are essentially the same as those in the *Akoustis-Qorvo* litigation. They are not. Neither Petitioner nor PO are named parties to that litigation. This fact should result in Factor 3 favoring institution.

Even putting this fact aside, the case schedule in the *Akoustis-Qorvo* litigation is likely to be extended to allow for necessary discovery if Akoustis' Motion for Leave to Add Patent Owner as a Co-Plaintiff is granted. This would result in significant investment still needing to take place in that case.

Moreover, despite PO's arguments to the contrary, Petitioner was more than diligent in bringing its Petition. PO's allegations about a 10 month delay from the filing of the complaint in the *Akoustis-Qorvo* litigation are misplaced. Again,

Petitioner is not, and was not ever a named Defendant in the *Akoustis-Qorvo* litigation, and Petitioner cannot reasonably be expected to monitor every federal district court docket for cases involving its customers. Instead, the only date that PO references that actually pertains to Petitioner is the date that Petitioner was served with a third-party subpoena. The fact that Petitioner filed its Petition only four months after being served with the subpoena, and *before* its Motion to Quash that subpoena was even heard, let alone resolved, highlights Petitioner's diligence.

Factor 4: First, PO misrepresents Petitioner's stipulation by stating that "Petitioner merely offers to not assert only those grounds that are instituted by the Board." POPR, 23-24. Not so. Petitioner in fact stipulated to not raise "any invalidity challenges based on the prior art asserted here," not just the specific grounds in the Petition. Pet., 74.

PO then compounds this misrepresentation by alleging both that Petitioner's "stipulation will not mitigate the overlap between the EDTX Litigation (or any other district court litigation) and the Petition," and that "Petitioner could have included a broader stipulation that might better address the duplicative efforts, and adhere to the purpose of *inter partes* review as an alternative to district court litigation." POPR, 30. Both allegations are predicated on a misrepresentation of Petitioner's role in, and influence over the *Akoustis-Qorvo* litigation. Petitioner is not a named defendant to that litigation, and thus a stipulation made by Petitioner

here (no matter how broad) would not prevent a different party from advancing certain invalidity positions in that litigation.

Nonetheless, as mentioned above, Qorvo made “a *Sotera*-type stipulation” in its own Petition, which necessarily alleviates any concerns raised by PO regarding “the purpose of *inter partes* review as an alternative to district court litigation.”

Tellingly, PO intentionally omitted any mention of Qorvo’s stipulation in its POPR, despite Qorvo filing its stipulation *two months before* the POPR was filed.

Factor 5: Again, neither Petitioner nor PO are named parties to the *Akoustis-Qorvo* litigation. This fact alone should result in Factor 5 favoring institution. PO’s arguments to the contrary are misplaced. Akoustis could have included Petitioner in the original complaint, or sought to have Petitioner added as a Co-Defendant in the *Akoustis-Qorvo* litigation, but it did not. Further undercutting PO’s narrative is the fact that Petitioner and Qorvo did not coordinate on the instant Petition, either as co-Petitioners or RPI. As such, the only thing linking Petitioner to the *Akoustis-Qorvo* litigation is a third-party subpoena served on Petitioner by Akoustis, which Petitioner sought to challenge in Massachusetts, only to have the motion transferred to EDTX. Thus, PO’s allegations that the parties to this proceeding are essentially the same as those in the *Akoustis-Qorvo* litigation are misplaced.

For at least the reasons presented in the Petition and above, and in light of Qorvo’s *Sotera*-type stipulation, denial under *Fintiv* is inappropriate.

Respectfully submitted,

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Date: July 9, 2024

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CERTIFICATION OF SERVICE (37 C.F.R. § 42.6(e))

The undersigned hereby certifies that on July 9, 2024, a true and correct copy of the foregoing **PETITIONER'S REPLY TO PATENT OWNER'S PRELIMINARY RESPONSE** was served in its entirety electronically via e-mail on the following parties:

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